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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,555	10/30/2003	Ian Burgess	2073.0120000/DSC/RLP	5931

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
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WASHINGTON, DC 20005

EXAMINER

PATTERSON, MARIE D

ART UNIT PAPER NUMBER

3728

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/20/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/696,555

Applicant(s)

BURGESS, IAN

Examiner

Marie Patterson

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16, 17 and 23-27 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7-15, 18-20 and 22 is/are rejected.
- 7) ☒ Claim(s) 3-6, and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 7, 12-15, 18-19, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Brue (6076282).

Brue '282 shows a shoe comprising a midsole (S) having at least one protrusion (1) disposed in a forefoot region, a plate (P) having at least one receptacle (2) disposed therein, the plate placed adjacent to the midsole such that the receptacle aligns with the protrusion (see figure 6), the "one or more" diameter of the receptacle is not greater than the diameter of the protrusion (see figure 6), an outsole fixedly attached to the plate and midsole (see col. 6 lines 22-56), the outsole is disposed along the entire length of the shoe (see figures 2-4 and 6), the plate is fixedly attached to the midsole (by 1a), a cutout (2) in the midsole wherein the protrusion is disposed in the cutout (see figure 6), the protrusion is disposed in the cutout such that an outward-most extremity of the protrusion approximately aligns with an outward-most surface of the midsole (see figure 6). With respect to the limitations of claims 18 and 19, the mere usage of Brue in the fashion disclosed would meet the claim limitations.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3728

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 8-10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brue '282 in view of Ludemann (6199304).

Brue shows a shoe substantially as claimed except for a sockliner having at least one nub disposed in a forefoot region on a lower surface and wherein the sockliner is placed on top of the midsole with the nub facing the midsole and an abrasion-resistant material attached to the upper surface of the sockliner with absorbent properties.

Ludemann '304 teaches that a sockliner (10) with an upper layer of abrasion resistant and absorbent material (see col. 3 line 27- column 4 line 28) can be placed on top of a midsole to aid in cushioning the user's foot and provide comfort to the user. It would have been obvious to place a sockliner as taught by Ludemann on the midsole of Brue to provide cushioning and comfort to the user's foot.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brue.

Brue shows a shoe substantially as claimed except for a stiff board disposed in the arch area of the shoe. It is well known and conventional to place lasting boards, a stiff board, in the arch area of shoes to give support to the user's foot during use. It would have been obvious to provide a last board in the arch of the shoe of Brue to aid in supporting the user's arch.

***Allowable Subject Matter***

6. Claims 16, 17, and 23-27 are allowed.

7. Claims 3-6 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

8. Applicant's arguments filed 1/31/07 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the protrusion having one or more diameters and the plate having a receptacle with a diameter and the "said one or more diameters of said protrusion are greater than the diameter of said receptacle" does not prevent the protrusion from having a nub or an additional diameter which is less than the receptacle, i.e. this language does not mean that the diameter of the receptacle is smaller than all diameters of the protrusion.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (572)273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson  
Primary Examiner  
Art Unit 3728